

The opinion in support of the decision being entered today was not written for publication and is not precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TIMOTHY J. CHAINER, DEAN A. HERMAN, JR.,
SOL KRONGELB, LUBOMYR T. ROMANKIW and EDWARD J. YARMCHUK

Appeal No. 1997-3472
Application 08/405,278

ON BRIEF

Before KRASS, FLEMING and HECKER, **Administrative Patent Judges.**

FLEMING, **Administrative Patent Judge.**

DECISION ON REQUEST FOR REHEARING

Appellants request that we reconsider our decision dated May 31, 2000, with respect to affirming the Examiner's decision rejecting claims 14-18 under 35 U.S.C. § 112, second paragraph.

Appellants argue on page 3 that claim 1, from which claim 14 depends, recites that the rotor is integrated with a disk in a one piece assembly. Appellants argue that claim 1 is broadly written and does not recite that the rotor must be directly attached coplanar to only the perimeter of the disk as shown in the Figure 1 embodiment. Appellants argue that claim 14 is another species in which the rotor 16d is now being defined with its cooperating rotor shaft 34d as joined to the plural disk. Appellants argue that the structure as recited in claim 14 is integrated with a disk in a one-piece assembly as claimed in Appellants' claim 1. On page 4 of the request for rehearing, Appellants further point to Appellants' specification arguing that it clearly discloses the one-piece ABS construction of a rotor shaft 34d and disk 12, and the rotor 16 formed on the shaft. Appellants argue that the specification expressly discloses at page 12, line 1+, that not only can magnetic coatings be applied to the surface of the ABS disk 12, but the entire rotor 16d may be formed from a suitable magnetic material. Appellants argue that this is

ample support in the specification for a one-piece assembly of the disk 12, rotor shaft 34d and rotor 16d recited in claim 14 and expressly illustrated in Figure 8.

In our May 31, 2000 decision, we interpreted Appellants' claim 14 language, "a plurality of storage disks coaxially joined to a rotor shaft and axially spaced from each other for allowing independent access thereto, and said rotor is coaxially joined to said rotor shaft and axially spaced from said disk for simultaneously rotating of said disk", as reciting separate pieces being attached together. We found that the structure recited in Appellants' claim 14 was not "a rotor integrated with said disk in a one piece assembly" as recited in claim 1 because claim 14 was reciting structure that included independent pieces being attached together which is not a one-piece integrated assembly. Having benefit of Appellants' arguments as set forth in the request for rehearing, we find that claim 14 language is simply labeling the parts of a one-piece assembly in which the rotor is integrated with the disk. We agree with the Appellants that in viewing the claim language in this light, the claim 1 recital of "a rotor integrated with a disk in a one-piece

assembly" is broad enough in scope to include the structure as recited in claim 14 in which the assembly is a rotor integrated with a disk in a one piece assembly in which there is a plurality of disks coaxially joined to a rotor shaft and axially spaced from said disk.

In view of this interpretation of claim 14, we thereby find that we can determine the scope of claim 14. Accordingly, we reverse the rejection of claims 14-18 under 35 U.S.C. § 112, second paragraph. Furthermore, we reverse the rejection of claims 14-18 under 35 U.S.C. § 103 for the same reasons that we set forth in our opinion dated May 31, 2000.

In regard to whether the specification supports the interpretation of claim 14 in which there is a disclosure of an integrated one-piece assembly having a plurality of storage disks coaxially joined to a rotor shaft and axially spaced apart from each other for allowing independent access thereto and said rotor is coaxially joined to said rotor shaft and axially spaced from the disk for simultaneously rotating of said disk, we note that this issue is not before us for our decision. We will leave this to the Examiner to determine if

Appeal No. 1997-3472
Application 08/405,278

there is a description as required by 35 U.S.C. § 112, first paragraph, within the specification to support such an interpretation of claim 14.

Appellants request for rehearing is granted.

GRANTED

ERROL A KRASS)	
Administrative Patent Judge)	
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MICHAEL R. FLEMING)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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STUART N. HECKER)	
Administrative Patent Judge)	

Appeal No. 1997-3472
Application 08/405,278

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Appeal No. 1997-3472
Application 08/405,278

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